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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,126	09/10/2003	Andrew M. Hoff	1372.23.PRWOUS	2125
21901	7590	03/19/2009		
SMITH HOPEN, PA 180 PINE AVENUE NORTH OLDSMAR, FL 34677			EXAMINER BHATIA, AARTI	
			ART UNIT 3763	PAPER NUMBER
			MAIL DATE 03/19/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/605,126	Applicant(s) HOFF ET AL.	
	Examiner Aarti Bhatia	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10,11 and 14-33 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-11 and 14-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9.10.2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the third Office action based on the 10/605,126 application filed on 10 September 2003. Claims 1, 3-8, 10-11, and 14-33, as amended on 10/28/2008, are currently pending and have been considered below.

Response to Amendment

1. The objections to claims 3 and 4 have been withdrawn in view of the amendments made by the Applicant.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims, 1, 3-8, 10-11, 14-16 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,968,006 to Hoffmann.

Hofmann discloses a method and apparatus for electromanipulation of chemical species in vivo relative to a target tissue (abstract) comprising: an substantially planar nonconductive sheet (20, 22) conformable to the three dimensional topography of the surface of the target tissue (column 4, lines 65-67); a plurality of electrode elements secured in spaced art relation on the array base (figure 1A), the electrode elements adapted to be coupled to a voltage controlled and current controlled electrical source (column 4, lines 24-56).

Hoffman further teaches that the electrodes are spaced in a manner so that sufficient voltage for permeation can be applied without inducing high voltage deeply in the underlying target (column 4, lines 52-56). It would have been obvious to one having ordinary skill in the art to vary the spacing of the electrodes to obtain the desired power or voltage since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

4. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofmann (U.S. Patent No. 5,318,514) in view of U.S. 2004/0039343 to Eppstein et. al.

Hofmann discloses the device of claim 1 but fails to teach at least one micro plunger adapted to deliver chemical species to the target tissue, whereby chemical species held with the at least one micro plunger are released through the at least one porous electrode element to the target tissue. Eppstein teaches a micro reservoir (figure 24) which is used with an electroporation device for drug delivery. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Hofmann by adding micro plungers so that multiple substances can be delivered or analyzed by the electromanipulation device (paragraphs 160, 174).

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aarti Bhatia whose telephone number is (571) 270-5033. The examiner can normally be reached on Monday-Thursday 8:00am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call (800) 786-9199 (IN USA OR CANADA) or (571) 272-1000.

/Aarti Bhatia/
Examiner, Art Unit 3763

/Nicholas D Lucchesi/

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Supervisory Patent Examiner, Art Unit 3763